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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/330,651	06/11/99	MARSHALL C	ODS-5

EXAMINER	
CHRISTMAN, K	
ART UNIT	PAPER NUMBER
3713	11

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Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary	Application No.	Applicant(s)	
	09/330,651	MARSHALL ET AL.	
	Examiner	Art Unit	
	Kathleen M Christman	3713	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *21 May 2001* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-30* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-30* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

15) ☒ Notice of References Cited (PTO-892)
16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) *9* .
18) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
19) ☐ Notice of Informal Patent Application (PTO-152)
20) ☐ Other: .

DETAILED ACTION

In response to amendment filed 05/21/01, claims 1-30 are pending in this application.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 11-13 and 26-28 are rejected under 35 U.S.C. 112, second paragraph, as failing to set forth the subject matter which applicant(s) regard as their invention. The structural limitations of the claim cannot perform the function of an "interactive wager system" or the method for "interactive wagering". This is evident that within a wagering system the user must be capable of placing a wager. The term "participant options" is not directed to options that would require the user to place a wager, in fact the limitations of the dependent claims state that a participant option is a horse or a jockey.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 10, 14, 15, 25, 29, and 30 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by WO/97/09699 to ODS Technologies, herein after '699. With regards to claims 10 and 25, '699 discloses a system and method for displaying an interactive wagering system in which the system receives user inputs and presents a series of displays each corresponding to a plurality of user selection requirements, wherein each display has a series of options that corresponds to the options for the user

selection requirements, an option can be designated as the selected option, and a "simulated wager ticket" is displayed. Figures 35-39 in particular show this method as it progresses through each screen. The "simulated wager ticket" as claimed by applicant is merely a summarization of the bet that the user is placing and is shown in Figure 39, and is described on page 25 line 21 through page 26 line 22. This section of txt also describes the ability to highlight an option that is selected.

With regards to claims 14 and 29, the system and method of '699 discloses the process of receiving user inputs, in response to receipt of one of the user inputs selecting a set of menu options that are a function of the current operating mode; and presenting a menu containing the set of menu options. The '699 specification discloses the ability for a user to enter two modes of operation while the user is operating it. The modes of operation are best shown in figure 3, wherein the user at step 172 may select a "view race track" mode an "account information" mode a "news and information" mode or a "bet on next race" mode. The user selection will then determine which information and menu options are displayed to the user. This is shown in the subsequent figures.

With regards to claims 15 and 30, '699 discloses a system and method for interactive wagering wherein the system receives user inputs, selects a wager based on the user options, and uses those options as the default selections for a subsequent wager entry process. As the applicant has not specified what the structural components or method steps of "a subsequent wager entry process" are, the examiner interprets that this merely the placement of another wager within the system. '699 discloses an option in which the user may "duplicate a bet", page 28 lines 20-26. This process creates a second wager identical to that of a first wager, thus using the already entered betting criteria as a default setting for the second wager.

5. Claims 5 and 20 are rejected under 35 U.S.C. 102(a) as being anticipated by Prather et al (US 5823872). Prather et al discloses a system and method for placing a wager in which, user inputs are received, a wager input interface is displayed having a plurality of user selection requirements and a plurality of options for each of the plurality of user selection requirements, wherein the plurality of user selection requirements are aligned in a first dimension, and wherein the plurality of options are displayed

such that they are aligned substantially in a second dimension with the one of the plurality of user selection requirements, see Figure 8. In the instance of Figure 8, the horses' names are the user selection requirements, and win, place, and show are the options.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. The factual inquiries set forth in *Graham* v. *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

8. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

9. Claims 1-4 and 16-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Massaro et al (US 5535321). The invention is drawn to a method and system for interactive wagering comprising the steps of, receiving user inputs; presenting one of an expert wager input interface and a novice wager

input interface based upon user inputs; interpreting the user inputs as specifically selecting the type of input wager interface (claims 2 and 17); switching from one interface to another interface (claims 3 and 18); and transferring wager selection information from one interface to another (claims 4 and 19). Massaro et al discloses a method and system for displaying an interface in which the user inputs the type of interface that is desired and is presented with that interface. The interfaces are differentiated by their level of difficulty, particularly "basic", "intermediate", and "advanced". It is well understood that one of ordinary skill in the art would understand that a "basic" and "advanced" are synonymous with "novice" and "expert" and removing the third "intermediate" level would be easily engineered. Col. 5: 30-57 describes the ability for a user to change the type of interface that is being presented. Additionally, it is taught in the above-cited area that the "override" feature may be invoked at any point in the process, this would include after the beginning of an interaction sequence. The ability to transfer information between various electronic forms is old and well known in the art. It would obvious to one of ordinary skill in the art to include this feature in the invention of Massaro et al so that a user of the system would not "lose" any work that has been completed in the system. The examiner notes that the invention of Massaro is not directed to a wagering system or wagering interfaces per say. However, it is disclosed that the system is meant to be used in any computer based interface system. See the entire disclosure, in particular the abstract, col. 1: 27-36, col. 2: 6-13, col. 2:62-67, col. 3: 38-46, col. 4: 2-12, col. 4 37-41, and col. 6: 15-25.

10. Claims 6-9 and 21-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of WO/9709699 and Prather et al (US 5823872). '699 teaches a system and method for interactive wagering that includes the user selection requirements of track selection, race selection, wager type selection, horse selection, and amount selection (claims 6 and 21) in figures 35-38, user inputs being used to select at least one of the plurality of options for each of the user selection requirements (claims 7 and 22) also in the above figures, the selected option being highlighted (claims 8 and 23) on page 25 line 21+ and a ticket window that indicates each of the plurality of options selected (claims 9 and 24) in figure 39. '699 does not teach the specific lay out as claimed by applicant. Prather et al discloses this layout in Figure 8. It would have been obvious to one of ordinary skill in the art to

modify the layout of the '699 publication with the layout as disclosed by Prather et al to allow for faster entry of wagering information. Additionally, the specific choice of layouts for an interface is a design choice and does not detract from the function or scope of an invention.

Response to Arguments

11. Applicant's arguments filed 05/21/01 have been fully considered but they are not persuasive. The examiner believes that each of these arguments has been addressed above.

Conclusion

12. Unless specifically noted in a section entitled "Allowable Subject Matter" all claims pending in this application are considered unpatentable.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kathleen M Christman whose telephone number is (703) 308-6374. The examiner can normally be reached on M-F 7:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Velencia Martin-Wallace can be reached on (703) 308-4119. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-3579 for regular communications and (703) 305-3579 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.

Kathleen M. Christman
Patent Examiner
July 18, 2001

Joe H. Cheng
Primary Examiner